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Remarks

Applicant has carefully considered the Office Action mailed on May 22, 2003. Claims 1-59 are pending in the present patent application. Of the pending claims, the Examiner indicated that claims 1-8, 21-23, 25-41, 43 and 56-59 contain allowable subject matter and claims 16-20 and 51-55 contain subject matter that would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In addition, the Examiner rejected claims 9-15, 24, 42 and 44-50. In response to the Office Action, Applicant amended claims 24 and 42 to overcome the 35 USC §112, second paragraph rejection. Applicant requests further examination and reconsideration of the present patent application.

The Examiner rejected claims 24 and 42 under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. As mentioned above, Applicant amended claims 24 and 42 to more particularly point out and distinctly claim the claimed subject matter. The amendments made to claims 24 and 42 are for clarification purposes and do not narrow the scope of the claims. Accordingly, Applicant requests that the Examiner reconsider and remove the §112, second paragraph, rejection of claims 24 and 42.

The Examiner rejected claims 9-15 and 44-50 under 35 USC §103(a) as being unpatentable over Gerber (US Patent Number 5,003,500) in view of Hasegawa et al. (US Patent Number 4,042,469). Applicant respectfully traverses the §103(a) rejection of the present patent application and submits that claims 9-15 and 44-50 are patentable over the combination of Gerber in view of Hasegawa et al. (hereinafter Hasegawa).

Independent claims 9 and 44 of the present invention each recites the limitation of determining a color formula that produces a measured color and satisfies accelerated weathering test requirements.

Gerber discloses a process and apparatus that determines a color formula that can reproduce the color of a sample. In particular, Gerber combines measured

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light signals taken from the sample with stored optical data to determine the color formula that can best reproduce the sample.

Hasegawa discloses a process for electrolytically coloring aluminum and aluminum alloys in gold. In one example, Hasegawa applies an accelerated weathering test to a finished specimen to see if there were changes to the specimen's colored surfaces.

In support of the combination of Gerber and Hasegawa, the Examiner submitted that it is a very well known desire in the art to have a color of an item maintain its integrity through exposure to weather. In support of this statement, the Examiner cited Hasegawa as an example and submitted that it would have been obvious to one of ordinary skill in the art at the time of the invention to calculate a formula in Gerber's invention that would pass accelerated weathering requirements.

Applicant respectfully traverses the rationale used by the Examiner to combine the teachings of Gerber with Hasegawa. Applicant submits that a person of ordinary skill in the art at the time of the invention would not have a reason or motivation to combine the teachings of Gerber with Hasegawa to yield the claimed invention. In particular, Gerber does not disclose or suggest the desirability of generating a color formula that satisfies accelerated weathering test requirements. Gerber does not contemplate or provide a hint or motivation that suggests the desirability of having its apparatus employ an accelerated weathering test to the sample or to any plaques made from the generated formula. Moreover, Hasegawa does not provide any reasons or motivations of using an accelerated weathering test with an apparatus like the one in Gerber that is interested in generating a color formula that can reproduce a desired color sample. Hasegawa is just an example that shows the use of an accelerated weathering test in electrolytically coloring aluminum and aluminum alloys. Applicant believes that the example provided in Hasegawa is not sufficient enough to motivate a person of skill in the art to modify the apparatus shown in Gerber to use an accelerated weathering test in its color formula determinations. Without a specific hint or motivation provided in either Gerber or Hasegawa that suggests the desirability of using an accelerated weathering test in an apparatus that is interested generating a color formula used to

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reproduce a sample, Applicant submits that a person of ordinary skill in the art would not have a reason to combine the teachings of Gerber with Hasegawa. As a result, Applicant submits that the §103(a) rejection under the combination of Gerber and Hasegawa is improper. Accordingly, Applicant requests that the Examiner reconsider and remove the §103(a) rejection of independent claims 9 and 44 and claims 10-15 and 45-50, which depend directly or indirectly from these claims, respectively.

Applicant appreciates the Examiner's indication that claims 1-8, 21-23, 25-41, 43 and 56-59 contain allowable subject matter. Applicant has reviewed the Examiner's reasons for allowing claims 1, 6, 16, 21, 25, 29, 33, 36, 41, 51 and 56. Applicant agrees that these claims are allowable over the prior art of record but does not acquiesce with the Examiner's reasons. In particular, Applicant believes that the Examiner's reasons for allowance for each claim are imprecise and have the potential to place unwarranted interpretations upon the claimed invention.

In view of the foregoing remarks and amendments, Applicant requests that the Examiner reconsider this application and allow claims 1-59.

If the Examiner has any questions regarding the present patent application, the Examiner can call Applicant's attorney, David Goldman, at telephone number (518)-387-5927 or (518)-387-5903.

Respectfully submitted,



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